

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<i>In re</i> Application of	)	
	)	Group Art Unit: 1652
E. GREEN <i>et al.</i>	)	
	)	Examiner: Meah, Mohammad Y.
Serial No. 10/700,472	)	
	)	Atty. Docket No. 000487.00026
Filed: November 5, 2003	)	
For: ETHANOL PRODUCTION		

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313

Sir:

In response to the Office Action mailed June 13, 2006, applicant elects *with traverse* group I, which includes claims 1-4, 7-12, 15 and 16.

Applicants traverse this restriction requirement because the two groups are not properly separated. The subject matter of Group II is totally and completely within Group I's subject matter. Group I is a genus (gram positive bacteria having alcohol dehydrogenase activity transformed with pyruvate decarboxylase gene) and Group II is a species within that genus (gram positive bacteria having alcohol dehydrogenase activity transformed with pyruvate decarboxylase gene which additionally has an inactivated lactate dehydrogenase gene).

Because of the genus-species relationship, the searches of the groups will be co-extensive. Moreover, our observations indicate that the use of the pyruvate decarboxylase gene

functions in the same way whether or not a bacterium has an inactivated lactate dehydrogenase gene. Specifically, the pyruvate decarboxylase gene improves the yield of ethanol.

For these reasons, we believe that restriction was improper and that there is unity of invention between the two groups of claims.

MPEP §806.04(d) specifies that a generic claim and a species claim should be examined in the same application. A species claim is defined as one which requires all the elements of the generic claim. The invention of Group II requires all the elements of the invention of Group I. Therefore, the Group II is properly a species of Group I's genus. Thus, examination of the two groups of claims together is proper.

The inventions of Group I and Group II are not "independent and distinct" as required by 35 U.S.C. § 121. Group II is dependent on Group I because there is a disclosed relationship between the two. As stated above, Group II is a species of Group I, requiring all the limitations of Group I.

Rejoinder of the two groups would not constitute a serious burden on the examiner for searching. The two have been classified in the same class and subclass. Any prior art that is relevant for one group of claims would likely be relevant for the other group of claims.

Withdrawal of the restriction requirement is respectfully requested .

Respectfully submitted,

Date: July 5, 2006

By: /Sarah A. Kagan/  
Sarah A. Kagan  
Registration No.32,151

BANNER & WITCOFF, LTD.  
Customer No. 22907